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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/041,141
Filing Date: January 03, 2002
Appellant(s): AGGARWAL ET AL.

Scott D. Paul
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/13/2010 appealing from the Office action mailed 11/13/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

This application has been appealed on 9/11/2006 and a Decision on the Appeal (Examiner Affirmed) was rendered on 8/29/2007.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-5 and 11 are pending in this application and are rejected. Claims 6-10 are canceled.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the

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appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Declaration under 37 C.F.R. § 1.131 filed on 12/21/2004 and 12/5/2005.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

706.03(w) Res Judicata

Res judicata may constitute a proper ground for rejection. However, as noted below, the Court of Customs and Patent Appeals has materially restricted the use of res judicata rejections. It should be applied only when the earlier decision was a decision of the Board of Appeals or any one of the reviewing courts and when there is no opportunity for further court review of the earlier decision. The timely filing of a second application copending with an earlier application does not preclude the use of res judicata as a ground of rejection for the second application claims. When making a rejection on res judicata, action should ordinarily be made also on the basis of prior art, especially in continuing applications. In most situations the same prior art which was relied upon in the earlier decision would again be applicable. In the following cases a rejection of a claim on the ground of res judicata was sustained where it was based on a prior adjudication, against the inventor on the same claim, a patentably nondistinct claim, or a claim involving the same issue.

In re Freeman, 30 F.3d 1459, 31 USPQ 2d 1444 (Fed. Cir. 1994). Edgerton v. Kingland, 168 F. 2d 121, 75 USPQ 307 (D.C. Cir. 1947). In re Szwarc, 319 F.2d 277, 138 USPQ 208 (CCPA 1963). In re Katz, 467 F.2d 939,

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167 USPQ 487 (CCPA 1970) (prior decision by District Court). In the following cases for various reasons, res judicata rejections were reversed. In re Fried , 312 F.2d 930, 136 USPQ 429 (CCPA 1963) (differences in claims). In re Szwarc , 319 F.2d 277, 138 USPQ 208 (CCPA 1963) (differences in claim). In re Hellbaum , 371 F.2d 1022, 152 USPQ 571 (CCPA 1967) (differences in claims). In re Herr , 377 F.2d 610, 153 USPQ 548 (CCPA 1967) (same claims, new evidence, prior decision by CCPA). In re Kaghan , 387 F.2d 398, 156 USPQ 130 (CCPA 1967) (prior decision by Board of Appeals, final rejection on prior art withdrawn by examiner “to simplify the issue,” differences in claims; holding of waiver based on language in MPEP at the time). In re Craig , 411 F.2d 1333, 162 USPQ 157 (CCPA 1969) (Board of Appeals held second set of claims patentable over prior art). In re Fisher , 427 F.2d 833, 166 USPQ 18 (CCPA 1970) (difference in claims). In re Russell , 439 F.2d 1228, 169 USPQ 426 (CCPA 1971) (new evidence, rejection on prior art reversed by court). In re Ackermann , 444 F.2d 1172, 170 USPQ 340 (CCPA 1971) (prior decision by Board of Appeals, new evidence, rejection on prior art reversed by court). Plastic Contact Lens Co. v. Gottschalk , 484 F.2d 837, 179 USPQ 262 (D.C. Cir.1973) (follows In re Kaghan).

a. Board affirmed the rejections of claims 1-10 on 08/29/2007.

b. The RCE and amended claims are filed on 10/29/07. The claims have been substantially amended to require a new ground of rejections using an additional prior art reference.

b. The amendment is filed 4/28/08 comprising amended claims 1-5 having limitations exactly the same limitations of claims 1-5 respectively that have been affirmed by the Board decision. Therefore, amended claims 1-5 filed on 4/28/2008 are rejected under the ground of *Res Judicata and made final*.

d. Examiner herein vacates the office actions mailed on 7/25/2008, 10/14/2008. It is noted that the Declaration (filed on 12/21/04 and 12/05/05) are filed before the Appeal Brief (filed on 7/13/06). Thus, this Declaration is also binding with the Board decision.

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The rejection affirmed by Board is included herein:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 5 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Upton et al., US 2003/0105884 A1, provisional filed 10/2001, in view of Jeffries et al., US 6,094,529, filed 12/1996 as supplied by the Applicants in IDS filed 01/03/2002, and “Instant HTML”, Homer et al., copyright 1997, pages 88-101.

Regarding independent claim 1, Upton teaches the steps of:

- detecting in a form-based submit, at least one validation error based upon a value provided through an input-element in a markup specified form (Upton, col.5, paragraph 62; user fill-out data and submits an html form, validating data in submitted form to detect invalid data);
- inserting a row in said markup specified form in a position which is proximate to said input element (Upton, col.5, paragraph 62, redisplaying the form with error message

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- next to each erroneous field. This inherently disclose inserting a text row next to erroneous field in the html form);
- selecting error text corresponding to said validation error and inserting said selected error text in said row (Upton, col.5, paragraph 62, redisplaying the form with error message next to each erroneous field); and
 - serving said markup specified form in a response to said form-based submit (Upton, col.5, paragraph 62).

Upton does not explicitly disclose that said row having a background color which differs from other colors which a visible in proximity to said inserted row; inserting an anchor tag in said markup specified form in a position which is proximate to said input element; and in a response to said form-based submit, said response referring said anchor tag.

Jeffries teaches error message is highlighted, such as by underlining, changing the background color to provide a visual indicator (Jeffries, col.3, lines 33-36 and col.5, lines 24-33).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Jeffries' visual indicator in error message into Upton's error message in html form to insert error text message having a background color which differs from other colors which a visible in proximity to said insert error text, since this would have provided a visual indicator for the user to focus on erroneous field in the html form. It is also noted that highlighting error data or error text field in an html form as a visual indicator for the user re-entries the data was well known in the art at the time the invention was made.

Homer teaches including an anchor within a page so that, when we load the page, that part of the document is automatically scrolled into view (Homer, page 88, "Anchors Within A

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Page” section; placing the anchor tag with name “dalmation” in section Dalmatians to directly scroll to that section when the page dog.html is loaded).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Homer’s teaching into Upton’s redisplay form to insert an anchor tag in the html form in a position which is proximate to said input element, since this would have allowed when the user submit the html form, error part of the html form is automatically scrolled into view Homer’s disclosed above for the user enter a correct data as. This would have facilitated the user to re-enter the data when the error field is directly provided.

Regarding claim 2, which is dependent on claim 1, Upton does not explicitly disclose inserting an error image adjacent to said input-element.

Jeffries teaches insert a glyph near highlighting text error message to provide a visual indicator (Jeffries, col.3, lines 33-36 and col.5, lines 24-33).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Jeffries’ glyph visual indicator in error message into Upton’s error message in html form to insert a image/glyph near the error text message, since this would have provided a visual indicator for the user to focus on erroneous field in the html form.

Regarding claim 5, which is dependent on claim 4. Refer to the rationale relied to reject claim 1, Upton, Jefferies and Homer teach inserting an anchor tag in said markup specified form in a position which is proximate to said input element. Homer also teaches the anchor tag place

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before the section to be automatically displayed (Homer, page 97, “Using Anchors in Your Pages” section).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Homer’s teaching into Upton’s redisplay form to insert an anchor tag in the html form in a position which is proximate but before to said input element, since placing the anchor tag before the error section would have allowed the error part of the html form is automatically scrolled into view as Homer’s disclosed above for the user enter a correct data as. This would have facilitated the user to re-enter the data when the error field is directly provided.

Claims 3-4 remain rejected and newly claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Upton in view of Jeffries and Homer as applied to claims 1 and 6 above, and further in view of Hartman, US 6,615,226 B1, filed 09/1997.

Regarding claim 3, which is dependent on claim 1, Upton, Jefferies and Homer teaches display error message proximate to said input element (error field) as explained above.

However, Upton does not explicitly disclose determining whether said markup specified form contained multiple views, one of said multiple view containing said input-element and if it is determined that said markup specified form contains multiple views, identifying said one of said multiple views and setting said identified one of said multiple views to a visible status

Hartman teaches a markup specified form contained multiple views, one of said multiple view containing said input-element (error field) (Hartman, col.9, lines 38-59).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hartman's teaching and Upton to includes the steps of determining said markup specified form contains multiple views, identifying said one of said multiple views and setting said identified one of said multiple views to a visible status, since this would have allowed error message to be displayed proximity to error field in both simple or/and complex form which contains multiple view to inform error for the user re-entries, since

Regarding claim 4, which is dependent on claim 1, Upton, Jefferies and Homer teaches inserting an error message row in said markup specified form in a position which is proximate to said input element, said error message row having a background color which differs from other colors which are visible in proximity to said inserted row in claim 1 above. Upton does not explicitly disclose that said position is proximate to but below said input element.

Hartman teaches displaying error message in close proximity but below said input element (Hartman, col.9, lines 55-59).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hartman and Upton to provide the error message on many different position proximate to the error input element to inform the user of error, since below or/and next is one form of proximate position.

Regarding claim 11, which is dependent on claim 1, refer to claim 1, the combination of Radtke, Jeffries, Hartman teaches the anchor tag is inserted after detecting the at least one validation error and prior to serving said markup specified form (Jeffries, fig.4; col.7, lines 1-16;

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inserting links to error messages, wherein each link is an anchor tag with “href” attribute). The rationale is incorporated herein.

(10) Response to Argument

Actual Reduction to Practice

On pages 4-6, 11 of the appeal brief, Appellants argue that “the test result submitted as part of the First Declaration provides sufficient evidence to establish that a successful test was made”.

Examiner respectfully disagrees. As explained in the Office Actions dated 5/6/2005 and specially 09/2/2005 (Response Argument, page 7), that, the written description and an illustrated test result on page 2 of Exhibit A can not qualify a reduction to practice, since they are not test results that actually run/occur successful from an apparatus. It is noted that the illustrated test result on page 2 of Exhibit A is not a screen shot(s) which was tested from a system or apparatus. Simply providing conception of the claim invention (Declaration provide “a disclosure document” which “describing an embodiment of the Invention”) and illustration/presentation how the conception works (Declaration demonstrates of error message displayed in a row below a user input field) do not indicate that test results actually existed/occur and was successful. Therefore, the Declarations filed on 12/21/2004 and 12/05/2005 are insufficient to establish a reduction to practice.

On page 10 of the appeal brief, Appellant provides argument relating to the Sixth Office Action dated July 25, 2008.

However, the Sixth Office Action dated 07/25/2008 has been vacated.

Constructive Reduction to Practice

On pages 6-9, 12-13 of the appeal brief, Appellants argue that “due diligence was exercised between just prior to the reference date of Upton and the execution of the “Declaration and Power of Attorney for Patent Application”

Examiner respectfully disagrees. The diligence must be proven from just prior to 10/18/2001 (the filing date of Upton et al.) and end with the date of reduction to practice, either actual or constructive (applicants' filing date) 01/03/2002. Based upon the evidence presented in declarations filed on 12/05/05, activities are summarized as following:

Prior October, 2001	Applicants conceived of the present applicant's invention.
October 18, 2001	Upton's filing date.
October 29, 2001	Applicants reviewed a final draft of the application.
November 8, 2001	Application executed the “Declaration of Power of Attorney for Patent Application” for the present application.
November 22, 2001	Thanksgiving day.
December 25, 2001	Christmas day.
January 1, 2002	New Year day.
January 3, 2002	Present application's filing date.

Based on the evidence presented in the declaration, there are apparent periods lacking activity and explanation from 10/18/01 to 10/29/01 AND 11/08/01 to 01/03/02. Although, applicants points out that there are three holidays and provide a listing of 20 patent applications

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between 11/08/01 to 01/03/02 period, however, applicants does not explain activities or procedures involving to such applications on this period except such holidays. The declaration fails to provide activities and particular facts associated with time that applicants are relying on to show completion without unexplained time gaps, therefore, the declaration filed on 12/21/2004 and 12/05/2005 are insufficient to establish diligence from a date prior to the date of reduction to practice of the Upton et al. reference to a constructive reduce to practice.

Res Judicata

On page 13 of the appeal brief, Appellants argue relating to Sixth and Seventh Office Action.

However, the Sixth Office Action dated 07/25/2008 and the Seventh Office Action dated 10/14/2008 have been vacated.

On pages 14-17 of the appeal brief, Appellants argue that “Examiner’s assertion that ‘this Declaration is also binding with the Board decision’ is incorrect” since “these Declarations were never presented in the First Appeal Brief, which resulted in the Decision dated August 29, 2007”

Examiner respectfully disagrees. All prosecutions and evidences in the file wrapper of this application, including the Declarations filed on 12/21/04 and 12/05/05 which filed before Board Decision dated 09/29/2007 are presented to Board. Although Board does not specifically mention about the Declarations, however, these Declarations are insufficient as explained in the response to argument above.

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The rejection of claims 3-4

On page 17-18 of the appeal brief, Appellants argue that dependent claims 3-4 are impossible, since Upton cannot qualify as prior art.

However, as explained in response to the arguments about Actual Reduction to Practice and Constructive Reduction to Practice sections above, Upton still qualifies as prior art, therefore, claim 3-4 are still rejected under 103 rejection.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Thu Huynh/

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